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REMARKS

Allocation of Customer Number

Applicants' counsel submitted form PTO-SB-122 with the Request for Continued Examination of March 1, 2006 and again with *Amendment C* on June 30, 2006. Form PTO-SB-122 was submitted for the purpose of allocating the customer number of Applicants' counsel. The submission of form PTO-SB-122 followed the prior submission of a revocation and power of attorney identifying the Applicants' customer number.

While the address for counsel of record appears on the cover sheet for the present *Final Office Action*, this application has not yet been associated with counsel's Customer Number. The Applicants request the Examiner's assistance with allocating Customer Number 22830 to the present application. By associating the Applicants' Customer Number with the present application, the Applicants may access the application via Private PAIR. The present application is unpublished and un-accessible via Public PAIR. The Applicants have submitted a third copy of form PTO-SB-122 with the present amendment.

Dual Final Office Actions

In the Examiner's communication mailed August 28—the *Final Office Action*—it appears as if the Examiner issued *two* office actions in the same mailing. While a cursory review of the two actions show a certain degree of similarity, the two actions do differ in a number of sections throughout. This difference is further reflected by the fact that the *first* of the two actions spans eighteen pages. The final page of the first action is dated August 23, 2006. The *second* action, however, spans nineteen pages; the final page of the second action is dated August 24, 2006.

The Applicants presume that the 'first' action dated August 23 was an earlier version (*e.g.*, a working draft) of the *Final Office Action* intended to be issued in this application. As the 'second' action bears the later date, it is presumed that this particular version was meant to be the final 'of record' version of the *Final Office Action*.

As such, the Applicants are responding to the second action that reflects a date of August 24 on the final page. All references to the *Final Office Action* and/or page numbers with respect to that action pertain to the aforementioned *second* action.

If the Applicants are in error (e.g., the Examiner meant for the 'first' action to be the *Final Office Action* or neither action was intended to be the *Final Office Action*), the Applicants respectfully request that the Examiner re-issue the *Final Office Action* and reset the period for response. The Applicants note that "[i]f [an] error [in an action] is brought to the attention of the Office within the period for reply . . . the Office will set a new period for reply." MPEP § 710.06. Further, the MPEP holds that that the new period "must be *at least 1 month* and would *run from the date the error is corrected*," MPEP § 710.06 (emphasis added). If the Applicants are in error, correction is necessary with respect to "properly communicat[ing] the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." *In re Hoch*, 428 F.2d 1351, 1342 n.3 (CCPA 1970). Should the Examiner issue an advisory action, a new non-final action or—as the Applicants believe is appropriate, a Notice of Allowance—the Applicants will presume that they have responded to the correct *Final Office Action* for this matter and this particular issue is resolved.

Amendments to the Specification and Abstract in Amendment C

In *Amendment C*, the Applicants presented amendments to the specification at: (1) page 18, line 12 to page 19, line 2; (2) page 82, lines 16-20; (3) page 118, lines 30-33; and (4) page 99, lines 1-9; and (5) the Abstract. Many of these amendments were at the request of the Examiner. As the Examiner did not indicate any objection to these amendments, the Applicants presume they have been entered into the record.

Amendments to the Cross-Reference Section

Originally Submitted in Amendment B

In *Amendment C* (June 30, 2006), the Applicants noted that “amendments to the cross-reference section [submitted in *Amendment B* (March 1, 2006)] were made to properly reflect the continuation-in-part priority claims of the present application as provided by 37 C.F.R. § 1.78(a)(1) and otherwise required by 37 C.F.R. § 1.78(a)(2)(i) and 37 C.F.R. § 1.78(a)(2)(iii).”¹ *Amendment C*, 10. These particular remarks were submitted in response to the Examiner’s contention that those amendments to the cross-reference section “will not be granted because [the cross-referenced] applications do not support the most recent claims amendments.” *March 31, 2006 Office Action*, 14. The Applicants respectfully contend that the Examiner misconstrues what the Applicants are attempting to achieve through the present amendment to the cross-section reference. The Applicants hope to clarify their intentions through this amendment below.

The Examiner states—in the present *Final Office Action*—that “the [previously identified] priority dates will not be granted because [the] above applications do not support the claim limitation ‘an interface apparatus’” *Final Office Action*, 14. The Applicants are not attempting to establish earlier priority for this particular claim limitation. The Applicants are only trying to identify the parent, Patent Cooperation Treaty, and provisional applications related to this application. The Applicants are not presently arguing that one of the aforementioned applications establishes priority for the

¹ The Applicants had previously sought to amend the cross-reference section to reflect that the present application is the U.S. national phase of Patent Cooperation Treaty application number PCT/US00/17078 filed June 21, 2000, which claims the priority benefit of U.S. provisional patent application 60/140,417 filed June 22, 1999. The Applicants also sought to note that the present application is a continuation-in-part and claims the priority benefit of U.S. patent application 09/720,277 filed March 12, 2001, which is the U.S. national phase of Patent Cooperation Treaty application number PCT/US99/14585 filed June 28, 1999, which claims the priority benefit of U.S. provisional patent application number 60/091,130 filed June 29, 1998. Further, the Applicants sought to note that U.S. patent application 09/720,277 is a continuation-in-part and claims the priority benefit of U.S. patent application 09/034,307 filed March 4, 1998 and now U.S. patent number 6,408,336, which claims the priority benefit of U.S. provisional patent application number 60/039,542 filed March 10, 1997 as well as U.S. provisional patent application number 60/040,262 filed March 10, 1997.

aforementioned claim element. See *Final Office Action*, 14.² Furthermore, the Applicants have cancelled the claim element 'interface apparatus' through the present amendments thus making the Examiner's prior basis for refusal moot.

To summarize, the amendments to the cross-reference section were not presented for the explicit purpose of antedating a particular cited reference or to otherwise evidence 35 U.S.C. § 112, ¶ 1 support for any particular claim limitation. The Applicants reserve the right to evidence such support, however, should the Examiner cite an intervening reference in a later action. At present, all the Applicants seek is the confirmation of the entry of the amendment with respect to the Cross-Reference section and permitted by 35 U.S.C. § 120, 37 C.F.R. 1.78, and MPEP § 201.11.

Entry of Amendments in the Current Amendment After Final

The Applicants have presented a number of amendments in the present amendment after final. The Applicants are aware that they "cannot, as a matter of right, amend any finally rejected claims." MPEP § 714.13(II). This same portion of the MPEP notes that amendments after final rejection are permissible, however, "where an amendment . . . adopts examiner suggestions, removes issues for appeal, or in some way requires only a cursory review by the examiner." MPEP § 714.13(II); see also 37 C.F.R. § 1.116(b)(2) (finding that "[a]fter a final rejection . . . [a]n amendment presented rejected claims in better form for consideration on appeal may be admitted"). The Applicants believe the present amendments qualify under one or more of the three aforementioned categories and wish to detail the basis for which they believe the present amendments should be entered notwithstanding the finality of the present rejection.

² This is also the reason why the Applicants "refrain[ed] from further comments" on this particular matter in *Amendment C* as the Applicants were not challenging whether the aforementioned claims support the 'interface apparatus' claim element. See *Final Office Action*, 13 (citing *Amendment C*, 11).

Annotated claim 1 as amended is presented here for the purpose of discussion. The Applicants have also numbered (1)-(6) the various 'groups' of amendments for the convenience of the Examiner.

An (1) interface apparatus for providing information in response to a query of a virtual database table, the interface apparatus comprising:
a virtual database service (2) , ~~the virtual database service comprising the virtual database table, wherein the virtual database table comprises one or more rows[[,]] and each of the one or more rows comprises comprising one or more fields; and~~
an information source (3) comprising ~~[[for]]~~ the information to be provided in response to the query of the virtual database table, (4) wherein the information source comprises an access evaluator configured to determine whether a user may have access to an information resource within the information source,
the query comprising a field name and an indication of manner for selecting a row, and wherein
the virtual database service is configured to:
receive the query; [[,]]
respond to the field name and the indication of the manner for selecting a row as required to obtain the information to be provided from the information source; [[,]] and
(5) provide ~~providing~~ the information as a value of the field indicated
by the field name in the selected row, in response to the query (6) , ~~and wherein the information source comprises an access evaluator, the access evaluator configured to determine whether a user may have access to an information resource within the information source,~~

The (1) cancellation of the claim language 'interface' overcomes the Examiner's previous rejections to this particular claim element under 35 U.S.C. § 112, ¶ 1. This amendment is believed to be permissible in that it adopts the examiner suggestions, removes issues for appeal, and requires only a cursory review by the examiner. This specific amendment to the preamble should also be permitted in the context of dependent claims 2-14.

The amendment to the (2) 'a virtual database' element improves the clarity of the claim and does not introduce new matter and/or require further consideration or search. See MPEP § 714.13(III)(B), (C) (concerning bases for rejecting an after final amendment). The specific amendment is presented here:

a virtual database service, ~~the virtual database service~~ comprising the virtual database table, wherein the virtual database table comprises one or more rows[[,]] and each of the one or more rows comprises ~~comprising~~ one or more fields; and

The cancellation of the recitation 'the virtual database service' and its preceding comma merely eliminates a repetitive recitation of the 'virtual database service.' The scope of the claim does not change. The introduction of the conjunction 'and' in tandem with the cancellation of the immediately preceding comma does not change the scope of the claim. The cancellation of the final 'comprising' in favor of the introduction of the language 'comprises' does not change the scope of the claim but becomes grammatically necessary as a result of the preceding introduction of the conjunction 'and.' As such, the Applicants believe this amendment to be permissible in that it requires only a cursory review by the Examiner.

The amendment to the (3) 'information source' element improves the clarity of the claim and does not introduce new matter and/or require further consideration or search. See MPEP § 714.13(III)(B), (C) (concerning bases for rejecting an after final amendment). The specific amendment is presented here:

an information source (3) comprising ~~[[for]]~~ the information to be provided in response to the query of the virtual database table,

The introduction of the claim language 'comprising' in conjunction with the cancellation of the language 'for' eliminates the colloquial 'possessive' nature of the information being 'for' the information source as previously presented. This amendment now reflects the relationship of the information source to the information in language more

appropriate for a patent claim and thus more apropos with respect to 35 U.S.C. § 112, ¶ 2. Thus, this particular amendment requires only a cursory review by the examiner.

The further introduction of the claim element 'of the virtual database' removes a potential issue for appeal as is referenced in the context of the Examiner's 35 U.S.C. § 112, ¶ 1 rejection (below) in that the Examiner contended that the specification did not disclose a virtual database table *and* an information source receiving a query. See *Final Office Action*, 4. This amendment makes it clear *what* exactly receives the query and the issue was obviously searched and considered by the Examiner in the previous action by virtue of that particular rejection. As such, the Applicants contend entry of this amendment to be appropriate. See MPEP § 714.13(II); see also 37 C.F.R. § 1.116(b)(2); c.f. MPEP § 714.13(III)(B), (C).

The Applicants' amendment concerning the (4) introduction of an access evaluator and the later (6) cancellation of that language are best considered in tandem. Claim 1 previously recited the (6) language now cancelled and shown here:

~~and wherein the information source comprises an access evaluator, the access evaluator configured to determine whether a user may have access to an information resource within the information source.~~

That cancelled language has merely been (4) relocated (introduced by amendment). This relocation in the claim body improves the claim and its readability without changing scope and/or requiring further search or consideration as can be seen here:

wherein the information source comprises an access evaluator configured to determine whether a user may have access to an information resource within the information source.

As such, the amendment (in both instances) constitutes one requiring only cursory review by the examiner. See MPEP § 714.13(II); c.f. MPEP § 714.13(III)(B), (C). The *only* change (other than particular location) is the deletion of a repetitive recitation of 'the access evaluator,' which does not affect claim scope; the claim is otherwise identical.

The final amendment concerns the virtual database service and the service's particularly claimed configuration; specifically its ability to (5) provide information. As can be seen from this amendment, the Applicants have removed the gerund 'providing the information' in favor of a particular configuration property—the ability to provide—which is more appropriate in the context of an apparatus claim. That is, the amendment is cosmetic and requires only a cursory review by the examiner and is thus believed to be appropriate for entry. See MPEP § 714.13(II); see also 37 C.F.R. § 1.116(b)(2); c.f. MPEP § 714.13(III)(B), (C).

The Applicants hope this detailed discussion of the amendments evidences the propriety of entering the same by the Examiner. The Applicants respectfully note that "[t]he refusal to enter the proposed amendment should not be arbitrary." MPEP § 714.13(III). The Applicants contend that the proposed amendments place the claims in condition for allowance (in light of the following arguments concerning 35 U.S.C. § 112, ¶ 1 and 35 U.S.C. § 102(b)) and, at worst, simplify issues for appeal. See MPEP § 714.13(III) (noting that "[t]he proposed amendment should be given sufficient consideration to determine . . . whether the issues on appeal are simplified"). The Applicants believe that they have explicitly evidenced the absence of new matter or the need for further consideration or search, which would constitute grounds for refusing to enter the amendment. See MPEP § 714.13(III)(B), (C). As such, entry of the amendments is respectfully requested.

Rejections Under 35 U.S.C. § 112, ¶ 1

The Examiner contends claims 1-14 are rejected under 35 U.S.C. § 112, ¶ 1 "as failing to comply with the written description requirement." *Final Office Action*, 2. The Examiner contends "[t]he claim(s) contains (sic) subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." *Final Office Action*, 2. The Applicants address each of the Examiner's rejections with respect to Section 112, paragraph 1 in turn below.

An Interface Apparatus

The Examiner maintains the previously rendered rejection with respect to “[t]he specification . . . not contain[ing] a clear and concise description of the manner and process of making an ‘interface apparatus’ such that a skilled technician can make and use the invention.” *Final Office Action*, 2. While the Applicants respectfully traverse—including the fact that the Examiner appears to be asserting a lack of enablement rather than lack of written description—in the interest of advancing prosecution, the Applicants have struck the language ‘interface’ from claims 1-14.

Claim 1 now recites ‘an apparatus for providing information in response to a query of a virtual database table.’ This amendment moots the Examiner’s Section 112, paragraph 1 rejection with respect to ‘an interface apparatus.’ While the present application is on final rejection, the Applicants believe the present amendment should be entered pursuant to 37 C.F.R. § 1.116(b)(2). Specifically, the amendment “present[s] rejected claims in better form for consideration on appeal” and is further detailed in this response under the section heading *Entry of Amendments in the Current After Final Amendment*.

Information Source

The Examiner maintains the previously rendered rejection that “[t]he specification does not contain a clear and concise description of the manner and process of making an ‘information source’ such that a skilled technician can make and use the invention.” *Final Office Action*, 3. The Applicants respectfully traverse. As previously noted in Applicants’ *Amendment C*, the Examiner’s 35 U.S.C. § 112, ¶ 1 rejection appears to be directed toward enablement rather than “failing to comply with the written description requirement” as initially indicated by this action. *Final Office Action*, 2; see MPEP § 2164 (noting “[t]he enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe *how to make and how to use the invention*”) (emphasis added); see also *Vas-Cath, Inc. v. Mahurkar*, 933 F.3d 1555, 1563 (Fed. Cir. 1991) (noting the written description and enablement are two separate and

distinct requirements of Section 112, paragraph 1). The Applicants do not believe an enablement rejection to be appropriate and thus address the Examiner's rejection in the context of a written description rejection as was initially suggested in the section heading for this rejection. See *Final Office Action*, 2.

As referenced in the *Summary of the Invention*, an embodiment of the presently described generalized policy server "presents the access control system as a virtual relational database table in which there is a row for every user-*information source* combination." *Specification*, 10:4-6 (emphasis added). "[T]he policy-enabled component addresses a query indicating the user and the *information source* to the table." *Specification*, 10:6-8 (emphasis added). The specification as it relates to FIGURE 29 discloses a "policy query 2939 com[ing] from policy server 2617 . . . and includ[ing] a specifier of the action to be performed as well as a specification of the *information source or other resource* upon which the action is to be performed." *Specification*, 88:17-19 (emphasis added). The specification also states that:

VDB service 3813 is able to respond to query 5403 even though table 5411 does not exist because it is able to use the information in the query's WHERE clause to locate and retrieve the results specified in the SELECT clause in one or more *information sources* 5409. Having retrieved the results, VDB service 3813 builds a constructed row 5417 corresponding to virtual row 5413 (i) selected by the query. Constructed row 5417 includes at least actual fields 5419 for the results that are to be returned for the query. Constructed rows 5417 are built for each query, and only as many are built for each query as are needed for the rows of the virtual table specified by the query. *Information sources* 5409 may include *information sources local to VDB service 3813 or non-local information sources, and may even include other databases.*

Specification, 99:13-21 (emphasis added).

The Examiner contends that "the only reference to an 'information source' [is found] under the heading of 'Dossiers.'" *Final Office Action*, 3. The Applicants respectfully contend this conclusion to be in error. The Applicants have identified no less than twelve separate instances of an 'information source' in the specification *prior to and exclusive of* the 'Dossiers' section. A number of those instances are highlighted

above. The Applicants believe that these explicit references to an information source sufficiently evidence the possession of the invention at the time the application was filed. As such, the Applicants believe the Examiner's written description rejection with regard to this particular claim element to have been overcome.

Virtual Database Service

The Examiner maintains the previously rendered rejection that "[t]he specification does not contain a clear and concise description of the manner and process of making the claimed 'virtual database service.'" *Final Office Action*, 3. The Applicants respectfully traverse. As noted in Applicants' *Amendment C*, the Examiner's 35 U.S.C. § 112, ¶ 1 rejection appears to be directed toward enablement rather than written description as initially indicated in the *Final Office Action*. The Applicants do not believe enablement to be at issue in the present application and thus address the Examiner's rejection in the context of a written description rejection as was initially indicated by the Examiner. See *Final Office Action*, 2.

As stated in the *Summary of the Invention*, "[a] *virtual database service* in the improved generalized policy server assembles the information needed for the query result using data sources that are accessible to it. In a preferred embodiment, the query is written in the well-known SQL language and the *virtual database service* emulates standard remotely-accessible database systems." *Specification*, 10:11-15 (emphasis added). This summary corresponds to the detailed description that notes

VDB service 3813 emulates a relational database protocol, the information which is being queried appears to be organized into a table which has a row for each potential user/potential resource combination for the resources controlled by policy-enabled component 2609 and columns that define fields in the rows. Each field in a row contains the row's value for the column to which the field belongs.

Specification, 97:30-98:1 (emphasis added). The detailed description continues:

VDB service 3813 is termed a *virtual database service* because the queries are made on a virtual relational table instead of a real one. The reason for this is that the queries dealt with by *VDB service 3813* are made to find out whether the access policies in policy database 3825 will permit a user who is requesting access to an information resource to have access to the information resource. A real relational database table for such queries would have to have a row in the table for each <potential user, information resource> pair, since any of the potential users may request access. In most applications the real relational database table would not only be unacceptably large, it would be undefinable, since there would be no way of knowing who all the potential users were.

Specification, 98:23-31 (emphasis added).

The Examiner contends that the Applicants "describe[] what is a 'real relational database table' but do[] not point to the specification for a description of a 'virtual database table' and 'virtual database service.'" *Final Office Action, 3.* The Applicants respectfully disagree as the specification, on page 98 (as cited above) clearly states that "queries are made on a virtual relational table *instead of a real one.*" *Specification, 98:23-24 (emphasis added).* The specification continues to discuss a *virtual* database service and *virtual* table in the context of a *real* relational database table in that:

[a] real relational database table for such queries would have to have a row in the table for each <potential user, information resource> pair, since any of the potential users may request access. In most applications the real relational database table would not only be unacceptably large, it would be undefinable, since there would be no way of knowing who all the potential users were.

Specification, 98:27-31.

The Applicants believe that these explicit references to a virtual database service sufficiently evidence the possession of the invention at the time the application was filed. As such, the Applicants believe the Examiner's rejection with regard to this particular claim element to have been overcome.

Virtual Database Table

The Examiner further rejects claim 1 under 35 U.S.C. § 112, ¶ 1 with respect to the specification allegedly failing to provide "the manner and process of making the claimed 'virtual database table.'" *Final Office Action*, 3. Again, the Applicants do not believe an enablement rejection to be appropriate and address the Examiner's rejection with respect to written description as was initially indicated. See *Final Office Action*, 2; see also *Final Office Action*, 4 (supporting the interpretation that the Examiner means to refer to written description in that the rejection states that the Applicants "fail[] to clearly point to references . . . for support for the claimed 'virtual database service' and 'virtual database table'"). Notwithstanding, the Applicants contend that the various references set forth above in the context of the virtual database and as discussed in the specification at page 97, line 30 through page 98 line 1 and, further, at page 98, lines 23-31 evidence the requisite written description for this claim element and that the Examiner's rejection is therefore overcome.

Response to the Query

The Examiner's final 35 U.S.C. § 112, ¶ 1 rejection pertains to the contention that "[t]he specification does not contain a clear and concise description of the manner and process of making the claimed invention." *Final Office Action*, 4. Specifically, the Examiner cites the following claim language as running afoul of Section 112, paragraph 1:

an information source for the information to be provided in response to the query, the query comprising a field name and an indication of manner for selecting a row, wherein the virtual database service is configured to receive the query

See *Final Office Action*, 4. The Examiner contends "the specification does not contain a clear and concise description of the manner and process of making the claimed invention because claim 1 claims a virtual database table receives a query and claim 1 also claims an information source receives a query." *Final Office Action*, 4. The

Applicants respectfully disagree and suggest that the Examiner may have misread the claim.

Claim 1 (as amended) reads as follows:

An apparatus for providing information in response to a query of a virtual database table, the apparatus comprising:

- a virtual database service comprising the virtual database table, wherein the virtual database table comprises one or more rows and each of the one or more rows comprises one or more fields; and

- an information source comprising the information to be provided in response to the query of the virtual database table, wherein the information source comprises an access evaluator configured to determine whether a user may have access to an information resource within the information source,

- the query comprising a field name and an indication of manner for selecting a row, and

- the virtual database service is configured to:

- receive the query;

- respond to the field name and the indication of the manner for selecting a row as required to obtain the information to be provided from the information source; and

- provide the information as a value of the field indicated by the field name in the selected row, in response to the query.

The particulars of the amendment to this claim have been discussed in detail under the section heading *Entry of Amendments in the Current Amendment After Final*.

Notwithstanding, the Applicants believe amended claim 1 clarifies the relationship and interaction of various claim elements and thus overcomes the Examiner's present and particular Section 112, paragraph 1 rejection. For example, the information source is not responding to a query as suggested by the Examiner in the *Final Office Action* but is, in fact, the source of information for a response to the query of the virtual database table.

Specifically, the information source (l. 7) provides information in response to a query of the virtual database table (l. 7-8). The information source is not subject to the query as was suggested by the Examiner. The virtual database service and its virtual database table are subject to the query (l. 1-2). The information source is just that—a source of information. This source of information ‘hosts’ the actual information provided in response to the query of the virtual database table as noted above. In light of this clarification of the claim language, the Applicants believe that the Examiner’s rejection of claim 1 is overcome.

Rejections Under 35 U.S.C. § 112, ¶ 2

The Examiner contends that “[c]laims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claimed the subject matter which (sic) applicant regards as the invention.” *Final Office Action*, 4. Specifically, the Examiner contends that ‘an interface apparatus’ “is indefinite as it is unclear how software can be included in [an] ‘interface apparatus.’” *Final Office Action*, 5. While the Applicants respectfully traverse the rejection, in the interest of advancing prosecution, the Applicants have struck the language ‘interface’ from claims 1-14. For example, claim 1 now recites ‘an apparatus for providing information in response to a query of a virtual database table.’ This amendment moots the Examiner’s indefiniteness rejection with respect to ‘an interface apparatus.’

Rejections Under 35 U.S.C. § 102(b)

The Examiner has rejected independent claim 1 as being anticipated by U.S. patent number 5,634,053 to *Noble et al.* See *Final Office Action*, 5. The Applicants previously traversed the Examiner's rejection in arguing that *Noble et al.* does not disclose 'an access evaluator configured to determine whether a user may have access to an information resource within the information source,' that 'evaluator' being comprised in the 'information source.' See *Amendment C*, 17; see also *Final Office Action*, 14 (referenced *Amendment C*, 17). The Examiner was "not persuaded" and countered that "the features upon which applicant relies (i.e. that evaluator being comprised in the information source) are not recited in the rejected claim(s)." *Final Office Action*, 15. The Applicants respectfully disagree.

Claim 1—as presently amended—recites in part that:

the information source comprises an access evaluator configured to determine whether a user may have access to an information resource within the information source

Placement of this particular claim element has changed to improve the readability of claim 1 and as discussed in detail under the section heading *Entry of Amendments in the Current Amendment After Final*. Otherwise, this claim element has consistently recited the aspect of the 'evaluator being comprised in the information source' notwithstanding the Examiner's contention to the contrary. The claim clearly states that the information source comprises an access evaluator.

The Examiner next suggests that the claim limitation "is not specific because of the word 'may.'" *Final Office Action*, 15. The Applicants traverse in that what is claimed is an apparatus of a particular configuration. Specifically, the apparatus comprises 'an information source' that 'comprises an access evaluator configured to determine whether a user may have access to an information resource within the information source.' In simple terms, the access evaluator determines whether access is granted or denied. That is, *whether a user MAY access the information resource*. This language is most certainly definite in nature per the requirements of 35 U.S.C. § 112, ¶ 2. Further,

the Applicants note that no specific rejection has been raised with respect to this claim element. See *In re Hoch*, 428 F.2d at 1342 n.3 (concerning properly communicating the basis of a rejection to allow for fair opportunity to reply to the same).

While the Examiner contends "it is difficult to determine what happens when access is not granted," the Applicants are unaware of any need to recite 'what happens' when access is not granted. A method is not presently claimed, wherein the outcome may be a dispositive aspect of the method. What the Applicants have claimed is an apparatus, which includes an information source comprising an access evaluator. The evaluator makes a determination of whether or not a particular action (access) may occur. The Applicants are unaware of any obligation per the U.S. Code or the C.F.R. to otherwise limit their claim by identifying what does or does not happen with respect to, specifically, interactions with the presently claimed access evaluator.

The Examiner, with respect to the merits of the Section 102(b) rejection, contends that *Noble et al.* is anticipatory based on the Examiner's interpretation of the claim element "in the context of the claims themselves, dictionary definitions (specialized and generic) and according to the level of ordinary skill in the art . . . to ensure that the claim language is given its broadest reasonable interpretation." *Final Office Action*, 16. The Examiner does not, however, identify what that interpretation is. Notwithstanding, the Examiner refers to the *Noble et al.* reference (sometimes referred to by the Examiner as Hughes (the assignee)) at column 3, lines 5-40. See *Final Office Action*, 16. The Examiner makes similar references to *Noble et al.* earlier in the body of the rejection at column 3, lines 15-35. See *Final Office Action*, 6. The Applicants respectfully traverse the alleged anticipation of claim 1 in light of these references to *Noble et al.*

Noble et al. discusses access to "meta-data stored in a UNIX file system from a remote site." *Noble et al.*, col. 12, l. 49. An SDD (Smart Definition Dictionary) server allows for "parsing, translating, optimizing, and coordinating the global and local queries" of the UNIX file system. *Noble et al.*, col. 12, l. 51-52. *Noble et al.* only discloses a knowledge-base-like dictionary server that assists in what appears to be freely accessible access through parsing, translating, coordinating, and the like. As such, the Applicants

respectfully contend *Noble et al.* fails to disclose each and every limitation of presently amended claim 1.

The Examiner—in a previous rejection—appeared to agree with the Applicants in noting that *Noble et al.* “does not disclose the access evaluator [that] determines whether the user may have access to the information resource.” *March 31, 2006 Office Action*, 8 (emphasis added). Notwithstanding, the Examiner now refers to column 3 of *Noble et al.* as evidencing such anticipatory disclosure. See *Office Action*, 6. Column 3, however, merely summarizes the discussion of *Noble et al.* with respect to column 12 and as summarized above.

Specifically, column 3 again refers to the aforementioned SDD dictionary. See *Noble et al.*, col. 3, l. 16. The SDD contains “a data information manager (DIM) that decomposes [a] global query into multiple local queries, and a plurality of local information managers (LIMs) that executes the local queries to search for and retrieve data from the local databases.” *Noble et al.*, col. 3, l. 17-21. There is no reference or suggestion as to the presently (and previously) claimed ‘access evaluator configured to determine whether a user may have access to an information resource within the information source.’

Noble et al. as cited by the Examiner continues in stating “a filter generates a list of these local databases that contain information relevant to the global query” in order to “improve search efficiency.” *Noble et al.*, col. 3, l. 22-24. Through this increases efficiency, “the filter . . . reduces the chances that the system will hang up.” *Noble et al.*, col. 3, l. 27-29. Again, there is no reference to an ‘access evaluator configured to determine whether a user may have access to an information resource within the information source.’

Finally, *Noble et al.* as cited by the Examiner, notes that “local queries will find and retrieve all of the relevant data requested by the user, not just the data that is represented in the exact same format as the global query.” *Noble et al.*, col. 3, l. 34-36. “Thus, the input translator [of *Noble et al.*] provides true integration of heterogeneous databases.” *Noble et al.*, col. 3, l. 36-37. Again, there is no reference whatsoever to an

'access evaluator' much less one 'configured to determine whether a user may have access to an information resource within the information source.'

As a claim is anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described," the Applicants contend anticipation to be lacking for want of, at least, the aforementioned recitation of an 'access evaluator configured to determine whether a user may have access to an information resource within the information source.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The Applicants therefore contend the Examiner's rejection of claim 1 to have been overcome.

Dependent Claims

Each and every one of the dependent claims of the present application depends either directly from—or via another dependent claim that ultimately depends from—claim 1 of the present application. As a dependent claim incorporates each and every limitation of the claim from which it depends under 35 U.S.C. § 112, ¶ 4 and the Applicants contend claim 1 is allowable for at least the reasons as set forth above, the Applicants contend each and every one of the dependent claims of the present application are allowable for at least the same reasons as claim 1.

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CONCLUSION

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The Applicants have evidenced proper 35 U.S.C. § 112 support for the various claim terminologies identified in, for example, claim 1 and believe the Examiner's related 35 U.S.C. § 112 rejections to have been overcome.

The Applicants have made moot the Examiner's 35 U.S.C. § 112, ¶ 2 rejection.

The Applicants have evidenced the distinctiveness of the independent claim of the present application versus *Noble et al.* and believe the Examiner's 35 U.S.C. § 102(b) rejection to have been overcome.

The Applicants have evidenced the permissibility of entering the various amendments presented herein notwithstanding the finality of the present rejection.

The Applicants respectfully request allocation of Customer Number 22830 to the present application.

The Applicants also request consideration of the concurrently submitted *Information Disclosure Statement*.


The Applicants further request confirmation as to the entry of the previously presented priority claim.

As all of the Examiner's rejections are overcome, the Applicants respectfully request the passage of the present application to allowance. The Examiner is invited to contact the undersigned with any questions concerning this amendment or the overall state of this application.

Respectfully submitted,
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